

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of
Applicants : Rogers et al.
Serial No. : 10/757,229
Filed : January 14, 2004
Title : **Printing Blanket Sleeve Having a Sound Dampening Feature**
Docket No. : DAY 0807 VA/40195.817
Examiner : San Martin, Edgardo
Art Unit : 2837
Conf. No. : 3259

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request review of the final rejection mailed September 27, 2006, in the above-identified application. No amendments are being filed with this Request. This Request is being filed with a Notice of Appeal. Review is requested for the reasons stated below.

Claims 1-9 are pending, and are rejected under 35 USC § 103(a) as obvious in light of Mahl (US 3,998,347), Caldwell (US 3,160,549), and Gold (US 5,150,943). Applicants submit that this rejection is clearly erroneous because the examiner has failed to establish a prima facie case of obviousness. Specifically, the examiner has failed to provide a motivation or suggestion, which would lead one of skill in the art to combine the teachings contained in the cited references.

To establish a prima facie case of obviousness, three basic criteria must be met. MPEP 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or

to combine reference teachings. *Id.* Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Id.* The teaching or suggestion to modify and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143.

As a starting point, Mahl provides no teaching of sound dampening or vibration dampening. Mahl's creep resistant sealing arrangement for a vacuum bell jar shows an elastomeric ring 22 comprising a flexible polymeric material with a J-shaped configuration. However, Mahl's J-shaped configuration is not a generally curved J-shaped configuration as recited in claim 1. Mahl also fails to disclose a strip of flexible polymeric material having a finite length as recited in claims 1 and 8; rather, Mahl teaches a ring structure. Mahl further fails to teach positioning a pressure sensitive adhesive on the inner surface of the J-shaped configuration.

Noting these deficiencies, the examiner proposed to combine the bell jar seal of Mahl with the Caldwell vibration damping structures used in airplane fuselage panels and boat hulls. The examiner asserted that it would have been obvious to make the combination, because the adhesive of the Caldwell structure would provide "ready-to-lay" convenience to the Mahl arrangement. However, one of ordinary skill in the art would not be led to modify Mahl, directed to flexible bell jar seals, by consulting Caldwell, directed to rigid vibration damping structures for boat hulls and airplane fuselages. "One cannot base obviousness upon what a person skilled in the art might try or might find obvious but rather must consider what the prior art would have led a person skilled in the art to do." *In re Tomlinson*, 150 USPQ 623 (CCPA 1966).

Furthermore, it is unclear how the examiner's proposed motivation of "ready to lay" convenience would provide guidance to one skilled in the art how to combine a flexible bell jar

seal with a pressure sensitive adhesive from a rigid damping structure used in a motor vehicle panel or airplane fuselage panel. There is no teaching or suggestion in Mahl that a seal for a bell jar needs or would benefit from a pressure sensitive adhesive, and there is no teaching that the combination would be successful. Mahl describes several ways to seal ring 22 to the bell jar; see Figs 3, 4, and 5. Only one, the Fig. 5 embodiment, uses an adhesive on an inner surface of ring 22. And, nothing in Mahl indicates that adhesive 40 is, or should be, a pressure sensitive adhesive. Mahl's primary need is to create a strong vacuum seal. Nothing in Caldwell indicates that a pressure sensitive adhesive, used for an entirely different purpose, would form an effective vacuum seal in Mahl. Whatever "ready-to-lay" convenience means, it cannot trump Mahl's need to form an effective vacuum seal. The only reasons to combine Mahl and Caldwell are luck or hindsight reconstruction, and neither of these constitutes a proper suggestion or motivation to combine. Even if the references are combined through luck or hindsight, neither Mahl nor Caldwell teaches a strip of flexible polymeric material having a finite length and a generally curved J-shaped or U-shaped configuration as claimed in claims 1 and 8, respectively.

Consequently, the examiner, after already combining Mahl, a reference directed to bell jar seals, with Caldwell, a reference directed to vibration damping structures in airplane fuselages and boat hulls, consults a third reference, Gold, which is directed to a mounting material for a portable van window. Specifically, Gold is cited for teaching a U-shaped flexible elastomeric mounting material 24 configured to straddle the edge 22 of a van window opening. Like Mahl, Gold provides no teaching or suggestion of sound dampening or vibration dampening. Without providing any motivation or suggestion from the cited references, the Examiner asserts one skilled in the art would know to combine Gold with Mahl and Caldwell because Gold's curved and bent shape would provide flexibility for the strip to match where it is

being mounted. However, flexibility is a general teaching, which would not lead one skilled in the art to incorporate a mounting from a van window with a bell jar seal or a vibration damping sheet used in airplane fuselage panels.

Additionally, the proposed modification of Mahl by Gold would render Mahl inoperable for its intended purpose. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). As shown in Fig. 2 of Mahl, the Mahl ring seal is directed to sealing a cylindrical bell jar by fitting the cross member against the *planar* rim of the jar. (Summary of the Invention). If the cross member 32 was modified to have a curved configuration (as allegedly shown by Gold), the curved cross member would not form an effective fit around the planar rim. Without a proper fit around the planar rim, the Mahl ring cannot perform its intended function of vacuum sealing a jar. As a result, modifying Mahl, as the examiner proposed, would render Mahl inoperable for its intended purpose. Accordingly, there is no teaching or suggestion to make the proposed combination of Mahl with Gold. As before, the only reasons to combine the Mahl, Caldwell, and Gold references are happenstance or hindsight reconstruction, and neither constitutes a motivation or suggestion to combine.

As the examiner states in the September 27, 2006 Office Action, the test for obviousness is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *See* 9/27/06 Office Action; *In re Keller*, 208 USPQ 871 (CCPA 1981). The Examiner's piecemeal reconstruction of Mahl, Caldwell, and Gold constitutes a clear misapplication of this test. Applying this test, it is illogical for one of ordinary skill facing a problem of providing sound damping to a rapidly rotating structure to conduct the following steps of: first, consulting a

reference in the unrelated art of flexible bell jar seals (Mahl); second, modifying the flexible bell jar seal to cure its deficiencies by consulting a reference directed to rigid vibration damping sheets found in airplane fuselages (Caldwell); and third, further modifying the combination of a flexible bell jar seal with a rigid vibration damping sheet by consulting yet a third reference in the unrelated art of mounting components for portable van windows (Gold). In short, one of ordinary skill in the art would not be led to combine the reference teachings as the examiner has proposed.

Accordingly, the examiner has failed to provide a motivation or suggestion to combine the cited references, a prima facie case of obviousness has not been established. For all of the above reasons, applicants respectfully traverse the rejection of the claims under §103(a), and respectfully request that the rejection be withdrawn and this application be allowed.

Respectfully submitted,

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